

REMARKS

No new matter is added by this amendment. The present application was filed on November 13, 2001 with original claims 1-53. By this amendment claims 1, 5, 17, 27, 29, 32, 35, 43, and 47 and claims 6-8, 10-12, 37, 39-42, and 44 have been cancelled. The claims remaining in consideration are claims 1-5, 9, 13-36, 38, 43, and 45-53.

Reconsideration is respectfully requested.

Claims 1-7, 9-12, 17-37, 39-41 and 46-52 were rejected under 35 USC §102(e) as being anticipated by US Patent Application 2003/0163262 by Corrigan et al ("Corrigan").

Claims 8 and 38 were rejected under 35 USC §103(b) as being unpatentable over Corrigan in view of US Patent Application 2002/0156917 by Nye et al ("Nye").

Claims 13-16 and 42-45 were rejected under 35 USC §103(a) as being unpatentable over Corrigan in view of US Patent Application 2003/0174143 by Rice et al ("Rice").

The claims have been amended to more clearly identify the subject matter applicants regard as the invention.

Amended independent claim 1 sets forth a computer system for providing a color solution to a customer. The system includes a color measurement device, a first module, and a second module. The color measurement device taking a color measurement of a part to be repaired. The color measurement includes color space values and reflectance values. The first module is located at a remote location and being adapted to receive a solution request from an operator. The solution request includes the color measurement. The second module is coupled to the first module and is located at a central location. The second module includes a composite solution database and a search routine coupled to the composite solution database. The second module receives the solution request from the first module. The search routine searches the composite solution database and determines the color solution as a function of the color space values and the reflectance values.

Corrigan provides a computer-implemented method and apparatus for matching paint for an automobile. As shown in Figure 1, the color match solution is based on the VIN, and if no matching paint color is found based on the VIN, then the color formulation is extrapolated based on the VIN and the color reflectance values (see Paragraph 0024).

Thus, as the Examiner correctly states, Corrigan does not teach measuring the color space values *and* the reflectance values and determining a color solution based on the color space values and the reflectance values as required by amended independent claim 1 (see the Examiner's rejection of original claims 13-16 and 42-45, on page 6, of the first office action).

In the Examiner's rejection of original claims 13-16 and 42-45, the Examiner utilizes Rice for teaching using color space values for paint matching. However, applicant respectfully asserts that Rice cannot be properly combined with Corrigan to teach the present invention as set forth in independent claim 1.

First, the system disclosed in Rice is not used to determine an acceptable paint formulation for a color solution. Rather, Rice is used to match a given color only close enough to provide *complementary colors* (see for example, paragraph 0011). Second, since the aim of the Rice system is to assist the user in selecting paint colors which are complementary to the input color, the Rice system only picks a "reference paint color" which is "visually closer" to the input color than any other color in the database. The reference paint color is not intended to be a substitute or to provide a formulation for the input color, but is only used to select the complementary colors.

The Examiner has the initial duty to *factually* support any prima facie conclusion of obviousness. This is adequately set forth in the MPEP:

2142 **Legal Concept of *Prima Facie* Obviousness [R-1]**

...

ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not be based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §243 - §2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references

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must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

As the Examiner realized, neither Corrigan nor Rice individually disclose all of the elements of amended independent claim 1. Furthermore, since Corrigan and Rice are aimed at different purposes, the motivation to combine their teachings is lacking. Thus, applicants respectfully assert that the Examiner has failed to factually support the conclusion of obviousness. Therefore, applicants respectfully assert the §103(a) rejection of independent claim 1 is improper and must be withdrawn.

Claims 2-4, 9, 11, 15-21, 22, and 24 are ultimately dependent upon allowable claim 1. Thus, for the reasons set forth above and based on their own merits, applicants respectfully assert that claims 2-4, 9, 11, 15-21, 22, and 24 are allowable.

Claim 5 has been amended to be in independent form and to more clearly identify the subject matter applicant regards as the invention. Independent claim 5 sets forth a computer system for providing a color solution to a customer. The system includes a first module and a second module. The first module is located at a remote location and receives a solution request from an operator at the customer. The solution request includes a customer identifier. The second module is coupled to the first module and is located at a central location. The second module includes a composite solution database and a search routine coupled to the composite solution database and receives the solution request from the first module. The search routine searches the composite solution database and determines the color solution as a function of the solution request. The second module includes a customer and solution usage database and stores customer information thereon. The customer information includes the customer identifier and information about the customer's use of the system.

Claim 35 has been amended to be in independent form and to more clearly identify the subject matter applicant regards as the invention. Independent claim 35 sets forth a computer based method for providing a color solution to a customer over a computer network. The method includes the step of receiving a solution request from an operator located at a remote location. The solution request includes a customer information including a customer identifier. The method also includes the steps of

delivering the solution request from the remote location to a central location over the computer network, searching a composite solution database and determining the color solution as a function of the solution request, and storing customer information on a customer and solution usage database.

In the rejection of original claim 8, the Examiner states that Corrigan “provides for customer information” (referring to paragraph 22, lines 6-11). In claim 5, the customer is the party seeking the paint solution. For example, the customer may be a collision repair shop seeking a paint formulation to paint a repaired vehicle to match the existing paint.

Corrigan does not teach a system or method which stores customer information, including a “customer identifier and information about the customer’s use of the system”, as required by independent claims 5 and 35.

The passage referred to by the examiner relates to information related to the vehicle being repaired, e.g., the VIN.

Further, the Examiner utilizes Nye for teaching storing information regarding the customer’s use of the system. Applicant respectfully asserts that Nye cannot be properly combined with Corrigan. Nye teaches a system which counts the number of times an advertisement is clicked by a user.

In contrast, the present invention as embodied in independent claim 5, records the customer identifier and other information regarding the customer’s use of the system. This is done, not to count the number of times an advertisement is accessed, but rather “to assist in planning for the future in terms of color trends and material requirements based on the requested color solutions” (see paragraph 0041). Thus, the proper motivation to combine the teachings of Corrigan and Nye is lacking. Therefore, applicants respectfully assert that amended independent claims 5 and 35 are allowable. Claim 38 is dependent upon allowable claim 35. Thus, for the reasons set forth above and based on its own merits, applicants respectfully assert that claim 38 is also allowable.

Claim 27 has been amended to more clearly identify the subject matter applicants regard as the invention. Amended independent claim 27 sets forth a system for providing a color solution to a customer. The system includes a color measurement device, a first module and a second module. The color measurement device is used to take a color

measurement of a part to be repaired. The color measurement includes color space values and reflectance values. The first module has a customer interface and is located at a remote location. The customer interface receives a solution request from an operator. The solution request includes the color measurement. The second module is coupled to the first module and is located at a central location. The second module receives the solution request, performs a consistency check on the solution request and responsively requests clarification from the operator if the solution request is not consistent. The second module includes a composite solution database and a search routine coupled to the composite solution database. The search routine searches the composite solution database and determines the color solution as a function of the color space values and the reflectance values.

Claim 32 has been amended to more clearly define the subject applicants regard as the invention. Amended, independent claim 32 sets forth a computer based method for providing a color solution to a customer over a computer network. The method includes the step of taking a color measurement of a part to be repaired by a color measurement device. The color measurement includes color space values and reflectance values. The method includes the step of receiving a solution request from an operator located at a remote location. The solution request includes the color measurement. The method further includes the steps of delivering the solution request from the remote location to a central location over the computer network and searching a composite solution database and determining the color solution as a function of the color space values and the reflectance values.

As discussed above, neither Corrigan, Nye, nor Rice teach measuring the color space values and the reflectance values and determining a color solution based on the color space values and the reflectance values as required by amended independent claims 27 and 32. Thus, applicants respectfully assert that amended independent claims 27 and 32 are also allowable.

Claims 28-31 are dependent upon allowable claim 27 and claims 33-34, 43, and 45-53 are ultimately dependent upon allowable claim 32. Thus, for the reasons set forth above and based on their own merits, applicants respectfully assert that claims 28-32 and 33-34, 43, and 45-53 are also allowable.

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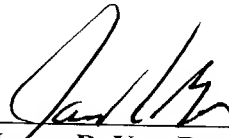
All of the Examiner's objections and rejections having been successfully traversed and/or made moot, applicants respectfully assert that the present application is now in condition for allowance. An early Notice of Allowance is respectfully requested.

Enclosed herewith is a check in the amount of \$176.00 to cover the fee for two additional independent claims. The Commissioner is hereby authorized to charge any additional fees or credit any overpayments to deposit account No. 08-2789.

Respectfully submitted

HOWARD & HOWARD ATTORNEYS, P.C.

November 10, 2004
Date




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CERTIFICATE OF MAILING

I hereby certify that this Amendment for United States Patent Application Serial Number 10/874,700 filed June 5, 2001 is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on **November 10, 2004.**


Melissa Dadisman

JRY/msd